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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,713	12/18/1998	MICHAEL WYNBLATT		1773

7590 03/19/2002

SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/215,713

Applicant(s)

WYNBLATT ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: original application filed 12/18/1998.
2. Claims 1-32 are currently pending in this application. Claims 1, 10, and 17 are independent claims.

Specification

3. The abstract of the disclosure is objected to because the abstract appears to be written as if it were a claim and is not in narrative form. See MPEP § 608.01(b).

Appropriate correction is required.

Claim Objections

4. Claims 18-26 have been renumbered in accordance with 37 CFR 1.126.
Examiner has renumbered claims 19-26 and their dependencies as following:
 - On page 14, line 1, claim 18 is renumbered as claim 19.
 - On page 14, line 5, claim 19 is renumbered as claim 20.
 - On page 14, line 7, claim 20 is renumbered as claim 21.
 - On page 14, line 10, claim 21 is renumbered as claim 22.
 - On page 14, line 13, claim 22 is renumbered as claim 23.
 - On page 14, line 20, claim 23 is renumbered as claim 24.

- On page 14, line 20, claim 23 is renumbered as claim 24.
 - On page 15, line 6, claim 24 is renumbered as claim 25. Its dependency is changed as “a method in accordance with claim 23”.
- On page 15, line 15, claim 25 is renumbered as claim 26. Its dependency is changed as “a method in accordance with claim 25”.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites “the annotation ID” (claim 22, line 12)

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by **Hou et al.** (U.S. 5,838,313 – filed 11/20/1995) as cited by Applicant (Specification; Page 1).

As to independent claim 1, Hou teaches a system for authoring, distributing, and replaying derivative hypermedia content, the system comprising:

- an authoring system for recording dynamic annotations (the dynamic annotation handler allows the user to record; col. 2, lines 40-61);
- a distribution system for distributing the dynamic annotations which have been recorded in the preceding step (send the report...received a report...a recorded annotation; col. 3, lines 1-13); and
- a playing system for playing the dynamic annotations which have been distributed in the preceding step (a recorded session can be played back; col. 3, lines 1-13).

As to dependent claim 2, Hou teaches the authoring system for recording dynamic annotations comprises: a system for capturing navigation events (the annotation-related events; col.7, lines 1-40).

As to dependent claim 3, Hou teaches the playing system for playing the dynamic annotations comprises: a system for playing the navigation events (provide events...by event filter; col.6. line 67- col.7, lines 10).

As to dependent claim 4, Hou teaches the dynamic annotations are recorded on hypermedia (recording....multimedia report; col.6, lines 52-67).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hou et al.** in view of **van Hoff et al.** (U.S. 5,822, 539 – filed 12/1995).

As to dependent claim 5, van Hoff teaches hyperlinks may be created and followed between the dynamic annotations (hyperlink annotation; col.5, lines 26-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would have provided the enhanced capability for facilitating distribution of hypertext link annotations.

As to dependent claim 6, van Hoff teaches a hypermedia browser (web browser; col.5, lines 56-61), the authoring and playing systems being included in the hypermedia browser and the distribution system being in part comprised in the hypermedia browser.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would have provided the enhanced capability for displaying hypertext link annotations.

As to dependent claim 7, van Hoff teaches a remote annotation server (a remote annotation proxy server; col.4, lines 9-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would have provided the enhanced capability for providing hypertext link annotations for documents requested over distributed computer network.

As to dependent claim 8, van Hoff teaches the distribution system is partly comprised within the hypermedia browser (web browser; col.5, lines 56-61) and partly within the remote annotation server (remote annotation proxy server; col.4, lines 9-21).

As to dependent claim 9, Hou teaches the remote annotation server further comprises an annotation store (annotation file; col.7, lines 1-3), and a mechanism for

indexing, retrieving and transferring annotation files (saved to a file...to the database...the message is delivered; col.4, lines 15-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would have provided the enhanced capability for retrieving and displaying hypertext link annotations.

As to independent claim 10, the rejection of claim 1 above is incorporated herein in full.

Claim 10 further recites:

- an annotation server
- a remote net server
- a net browser

Hou, however, does not explicitly teach the limitations detailed above.

van Hoff teaches:

- an annotation server (annotation proxy server; col.4, lines 22-38)
- a remote net server (remotely located information server computer; col.4, lines 1-8)
- a net browser (web browser; col.5, lines 56-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would have provided the enhanced capability for providing hypertext link annotations for documents requested over distributed computer network.

Dependent claim 11 includes the same limitations as in claim 2, and is similarly rejected under the same rationale.

As to dependent claim 12, Hou teaches an annotation store (annotation file; col.7, lines 1-3).

As to dependent claim 13, van Hoff teaches hyperlinks may be created and followed between annotations (hyperlink annotation; col.5, lines 26-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would have provided the enhanced capability for facilitating distribution of hypertext link annotations.

As to dependent claim 14, Hou teaches an annotation manager (the annotation on annotation handler; col.2, lines 50-61), an annotation recorder (record a session of dynamic annotation; col.2, lines 50-61), and an annotation player (playback and an annotation on annotation handler; col.2, lines 40-49)

As to dependent claim 15, Hou teaches an Annotate mode wherein events generated by a user are recorded (the annotation-related events...are input to the annotation file; col.7, lines 1-10), and a Watch mode wherein a most recent annotation is played (the dynamic annotation can be displayed; col.8, lines 43-48).

van Hoff teaches a selectable Browse operating mode (the browser 110 for viewing on the requesting client computer; col.6, lines 33-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would have provided the enhanced capability for providing hypertext link annotations for documents requested over distributed computer network.

As to dependent claim 16, Hou teaches the system displays available annotations for each document that a user visits (the dynamic annotation handler allows the user to record/playback annotations from the user input; col.2, lines 50-61).

As to independent claim 17, the rejection of claim 1 above is incorporated herein in full. Claim 17 further recites “selecting one of a Browse mode, an Annotate mode, and a Watch mode”.

Hou teaches an Annotate mode (the annotation-related events...are input to the annotation file; col.7, lines 1-10), and a Watch mode (the dynamic annotation can be displayed; col.8, lines 43-48).

Hou, however, is silent on “a Browse mode”.

Van Hoff teaches a Browse mode (the browser 110 for viewing on the requesting client computer; col.6, lines 33-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would

have provided the enhanced capability for providing hypertext link annotations for documents requested over distributed computer network.

As to dependent claim 18, Hou teaches the causing events generated by a user to be recorded includes causing navigation events to be recorded (events are recorded; col.7, lines 1-51).

As to dependent claim 19, Hou teaches the causing a most recent annotation to be displayed includes causing navigation events to be displayed (provide events...by event filter; col.6. line 67- col.7, lines 10).

As to dependent claim 20, Hou teaches the Browse mode, the Annotate mode, and the Watch mode are selectable by screen button functions (the user selects a file name... the user selects a message; col.4, lines 1-14).

As to dependent claim 21, Hou teaches selecting one of a drawing mode and a typing mode (allows the user to add drawings and text; col.2, lines 50-61).

As to dependent claim 22, van Hoff teaches generating a link annotation event using the annotation ID of the item selected (hyperlink annotation; col.5, lines 26-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would have provided the enhanced capability for facilitating distribution of hypertext link annotations.

As to dependent claim 23, Hou teaches pausing recording of annotation; loading a document with given ID; rendering the document by the net browser; and resuming recording of annotation (pause/resume the recording; col.6, lines 51-67).

As to dependent claim 24, Hou teaches entering information including a user-selected name associated with a most recent annotation; generating an annotation file (annotation file; col.7, lines 1-3); sending the name and the annotation file to the annotation server; extracting document ID's from NEW DOCUMENT events in the annotation; and storing a file with the information in an Annotation Store indexed by the document ID's (identify related annotations; col.9, lines 14-32).

As to dependent claim 25, Hou teaches the Annotation manager sending an ID (identify related annotations; col.9, lines 14-32) of the new document to the Annotation server; upon the Annotation server finding any annotations stored for the ID of a new document, the Annotation server sending annotation files along with any associated names and icons to the Annotation Manager, the Annotation Manager displaying annotation's name (the dynamic annotation can be displayed; col.8, lines 43-48), author's name if any, and icon if any, of each annotation in an Annotation Manager box.

As to dependent claim 26, Hou teaches the Annotation manager sending an ID of a new document to the Annotation server; upon the Annotation server finding no annotations stored for the ID of a new document, the Annotation alerting the Annotation Manager that there are no annotations for a current page (the annotation on annotation handler operates...there is a decision...should be annotated; col.5, lines 10-28).

As to dependent claim 27, Hou teaches processing events in a traditional manner in a Main Annotation Playback Loop (the filtering of events begins...decision block 54 determines; col.7, lines 51-65).

As to dependent claim 28, Hou teaches pausing playback of annotation (pause/resume the recording; col.6, lines 51-67); loading a document having a selected ID (load a data object into the canvas; col.7, lines 7-36) rendering the document; and continuing playback of the annotation (annotation playback; col.8, lines 1-17).

As to dependent claim 29, Hou teaches if the playback is complete, verifying whether an Annotation Stack is empty and, if so, switching to the Browse mode and, if not, taking the top annotation from the stack and beginning playback from the designated event (the annotation scheduler...drops actions...provides filter actions; col.8, lines 1-17).

As to dependent claim 30, van Hoff teaches when the Watch mode is selected, and upon processing of a link annotation event, creating a temporary Link Button which remains available to the user for a pre-determined length of time (when explicit specification of a proxy is required or desired... clicking one or more buttons on the client web page; col.6, lines 5-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of van Hoff with Hou because it would have provided the enhanced capability for displaying hypertext link annotations for documents requested over distributed computer network.

As to dependent claim 31, Hou teaches the steps of, when the Watch mode is selected, and upon activating the Link Button, placing the ID of the active annotation, along with the index of the next event in the active annotation on the top of the stack; beginning playback of an annotation referenced in the most recent link annotation event (for annotation playback...schedules for each lip-sync interval; col.8, lines 1-18).

Dependent claim 32 includes the same limitations as in claim 29, and is similarly rejected under the same rationale.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pizano et al.	U.S Patent No. 6,105,055	issued dated: Aug. 15, 2000
Drews et al.	U.S Patent No. 5,893,126	issued dated: Apr. 6, 1999
Rangan et al.	U.S Patent No. 6,006,265	issued dated: Dec. 21, 1999
Rangan et al.	U.S Patent No. 6,154,771	issued dated: Nov. 28, 2000

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092.

The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Art Unit: 2176

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.


OFFICIAL faxes must be signed and sent to (703) 746-7239.

NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen
March 11, 2002


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